

REMARKS/ARGUMENTS

A PETITION FOR EXTENSION OF TIME has been filed, concurrently with this Amendment, extending the time for response to the Official Action three (3) months, from June 8, 2006 to September 8, 2006. The Commissioner of Patents is authorized to charge the extension fees, namely, \$510.00, from Deposit Account 04-1679.

As a result of this Amendment, new claims 30-36 are under active consideration in the subject patent application.

In the Official Action, the Examiner has:

- (1) entered claims 12-29 as amended by Applicant on September 13, 2005 and December 27, 2005;
- (2) acknowledged the IDS filed on January 25, 2006;
- (3) rejected claims 12-16, 21-24, and 29 under 35 U.S.C. § 103(a) in view of a proposed combination of U.S. Patent No. 3,006,659, issued to Krasnoff et al. (the "Krasnoff reference"), and U.S. Patent No. 4,033,596, issued to Andorsen et al. (the "Andorsen reference");
- (4) rejected claims 12-17, 19, 21-25, 27 and 29 under 35 U.S.C. § 103(a) in view of a proposed combination of the Krasnoff reference with WO 00/53276, filed by Rosso et al. (the "Rosso reference"); and
- (5) rejected claims 18, 20, 26, and 28 under 35 U.S.C. § 103(a) in view of a proposed combination of the Krasnoff reference, the Rosso reference, and U.S. Patent No. 5,251,934, issued to Gates (the "Gates reference").

With regard to Items 1-6, Applicant has cancelled claims 12-29 and introduced new claims 30-36 in order to more particularly point out and distinctly define the present invention in view of the prior art that has been relied upon by the Examiner. Support for these new claims may be found throughout the application as originally filed. No new matter has been entered into the claims as a result of the introduction of these new claims.

Applicant respectfully traverses the Examiner's proposed combinations of the Krasnoff reference with the Rosso reference and/or the Gates reference for the following reasons. New main claims 30 and 36 are limited to the rider standing side-stance with both feet fully supported on the board. The term of art "side-stance" is commonly accepted among those skilled in the art to describe the standard riding position on skateboards. This clearly differentiates the apparatus of the present invention from both scooters and skates as disclosed in the Krasnoff, Andorsen, Rosso, and Gates references inasmuch as the devices taught or suggested by these references are not and can not be ridden side-stance.

In order for a prima facie case of obviousness to be established, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, and the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2142 [emphasis added]. Neither Krasnoff nor Andorsen, Rosso, and Gates taken alone or in any valid combination with one another teach or suggest an all-terrain skateboard apparatus

capable of allowing a rider to stand side-stance, with both feet fully supported on the board.

With regard to the teachings of the Krasnoff reference there is simply no disclosure or hint in the specification that the treadle scooter can be ridden with both feet on treadle (60). Thus, the Examiner's statement (in paragraph 4 of the office action) that the Krasnoff device is a riding board adapted for use with both feet of a user is simply not supported by the specification of that reference. Firstly, Krasnoff's device is not a riding board at all - it is a treadle scooter. Secondly, Krasnoff's specification does not contemplate a rider using the device with both feet fully supported on treadle (60). There is absolutely no possibility of the device of Krasnoff being ridden in a side-stance manner. Significantly, it is not at all clear what would happen to the treadle scooter of Krasnoff if the rider were to be riding on the board with both feet (as postulated by the Examiner). It appears very likely, based upon the drawings and written disclosure in that reference, that the entire device would be extremely unstable. This instability is clearly suggested by the fact that the Krasnoff device has handle bars which are presumably needed to provide rider stability.

Since there is no motivating disclosure or suggestion in the specification or drawings of Krasnoff to support the Examiner's position (*and it would constitute impermissible hindsight to derive the requisite motivation from Applicant's claims*) the only place for such motivation to combine must be found in Andorsen, Rosso, and/or Gates taken as a whole with the Krasnoff reference. The requisite motivation is not anywhere to be found in these references. All of the cited prior art is directed to skate

members designed to be operated with one foot per skate. There is no disclosure of any apparatus arranged to be ridden by the rider with two feet on a board. Andorsen, Rosso and Gates all disclose and suggest roller skates (one on each foot) which have stability provided by the lateral disposition of the two skates. Skateboards, such as that of the present invention, do not have any such stability and so brakes must be applied in a very different manner and construction.

As to the combination of Krasnoff and Andorsen, these are both stabilized devices. The Krasnoff scooter has handle bars and the Andorsen roller skates have three wheels on each foot. Being able to activate brakes on stabilized platforms is very different to being able to brake on a skateboard where the rider's feet cannot move. More particularly, skateboarders ride their boards side-stance. To therefore create a skateboard skating system that operates from leaning back against a lever is not only unique to Applicant, but is contrary to common practice. In fact, leaning back in a side-stance position to operate a braking member is very different from leaning back on roller skates and scooters where the rider's feet are pointing straight forwards. Moreover, it is clear from the drawings of Andorsen that he never contemplates the use of both feet on a single skate. Apparently Andorsen's device is simply not large enough to accommodate both feet of a rider on one skate, i.e., the skate does not have a width that is sufficient to provide full support to a rider's feet when standing side-stance with both feet on the skate. Thus, Andorsen does not teach, suggest, or provide the missing motivation to be combined with Krasnoff to suggest an all-terrain skateboard apparatus

capable of allowing a rider to stand side-stance, with both feet fully supported on the board.

With regard to the proposed combination of Krasnoff with Rosso, Krasnoff's treadle scooter can not be ridden side-stance with the rider's both feet on treadle (60). Rosso fails to provide this missing teaching to Krasnoff. More particularly, the Rosso reference (like Andorsen) relates to roller skates of the type where one foot is placed in each of two skates (see, Fig. 7 of Rosso). Thus Rosso relates to a pair of skates and not an individual board. In stark contrast to the device defined by new claims 30-36, Rosso's device is arranged to have a foot with a knee lever, where the foot of Rosso's skater is not firmly placed on a rigid deck, let alone on a deck having a width that is sufficient to provide full support to a rider's feet when standing side-stance with both feet.

With regard to the proposed combination of Krasnoff with Rosso and Gates, Krasnoff's treadle scooter can not be ridden side-stance with the rider's both feet on treadle (60) and the Rosso reference clearly teaches roller skates of the type where one foot is placed in each of two skates. The addition of Gates to this combination fails to provide the missing teachings related to an all-terrain skateboard with a board having a width that is sufficient to provide full support to a rider's feet when standing side-stance with both feet. Instead, Gates provides a pair of roller skates as well, with rim brakes operated by hand levers on the ends of flexible cables (see Fig. 1 of Gates). Gates simply has no relevance whatever to the present invention as defined by new claims 30-36, which provide an all-terrain board that is constructed with a board having a width

that is sufficient to provide full support to a rider's feet when standing side-stance with both feet on the board. None of the foregoing structure is even vaguely suggested by Gates alone or in combination with the disclosure of Krasnoff or Rosso.

Since nothing in the prior art references would lead a person of ordinary skill in the art to design a skateboard like that described in the present application, or defined by new claims 30-36, it appears that hindsight knowledge of the present invention is the only motivation to combine these references. Applicant respectfully submits that the motivation to combine references cannot come from the invention itself. See, In re Oetiker, 24 U.S.P.Q. 2d 1443, 1446. Moreover, it is improper to use the claims of a pending application as a framework to which individual parts of separate prior art references are grouped to recreate a facsimile of the claimed invention. See, W.L. Gore and Associates, Inc. v. Garlock, Inc. 220 U.S.P.Q. 303, 312.

In summary, Applicant submits that the unique apparatus defined by new claims 30-36 is not disclosed in the prior art references, taken as a whole, and there is no teaching or suggestion in the references to support their use in the particular claimed combinations. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.